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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,364	06/19/2001	Johannes Hendrikus Van Lith	PB0013/US	1078

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EXAMINER

JOHNSON, VICKY A

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,364

Applicant(s)

VAN LITH ET AL.

Examiner

Vicky A. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (US 5,169,369) in view of Takagi (JP-1-247841).

Masuda et al disclose a driving belt comprising: a carrier consisting of two endless band packages (34) lying side by side (see Fig 5), on which transverse elements (32) are disposed freely movable in a longitudinal direction of the band (col. 2 lines 56-65), the transverse element is a single piece of material (see Figs 4 and 5) wherein each transverse element includes two recesses (68) positioned opposite each other for receiving the band packages (see Fig 5), so that a first part (36) of the transverse element extends under the band packages, a second part (40) of the transverse element is positioned between the band packages, and a third part (38) of the transverse element extends above the band packages, wherein the front side of the first part (36) transverse element includes a tilting line (L) extending in a horizontal direction and forming a transition between a part of the element at least including the third part (38) that has a constant thickness and a part of the element wherein the thickness tapers downward away from the tilting line (see Fig 4), a projection (72) which can mate with a recess (80) in a manner allowing in the adjacent transverse element

free movement of adjacent elements in the longitudinal direction of the belt (col. 2 lines 56-65), wherein the projection and the recess are at least partially formed in the second part of the transverse element (see Fig 6) and wherein the projection is disposed some distance above the tilting line (see Fig 6), which has a distance smaller than the smallest vertical component of the recess (see Fig 6).

Masuda et al do not disclose that the projection and the recess extend in the horizontal direction over the entire dimension of the second part.

Takagi discloses that the projection and the recess extend in the horizontal direction over the entire dimension of the second part.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the projection and recess of Masuda et al to extend in the horizontal direction over the entire dimension of the second part as taught by Takagi in order to improve the efficiency of power transmission (Abstract).

Masuda et al do not disclose that the transverse elements are made of metal.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the transverse elements of Masuda et al of metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

Regarding the limitation that the transverse element is "cut" and the limitation that the recess is a deformation recess and the projection is formed on the transverse element from displaced deformation material forming the recess has not been given patentable weight. Even though product-by-process claims are limited by and defined

by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

Re claim 2, Masuda et al show the projection and the recess are entirely located in the second part of the transverse element (see Fig 6).

Re claim 13, Masuda et al show a surface (76) of the projection (72) comprises a recessed part (the surface 76 is recessed inward between the two projections 72 and 74) and the recess (80) comprises a projecting part (unnumbered surface between the recesses 80 and 82) which extend at an angle to a horizontal line in the plane in which the band packages lie (see Fig 4).

3. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (US 5,169,369) in view of Takagi (JP-1-247841) as applied to claims 1, 2, 10, and 12 above, and further in view of Maruyama (EP-421804).

Masuda et al disclose the claimed invention as described above, but does not disclose that the edges of the transverse element have been deburred.

Maruyama discloses that the edges (10) of the transverse element have been deburred and rounded (see Fig 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include round the edge of the transverse element as taught by

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Maruyama in the driving belt of Masuda et al so that the transverse element comes into firm contact with the pulley walls (col. 3 lines 44-53).

Response to Arguments

Some further comments regarding the Applicant's remarks are deemed appropriate.

The applicant argues that the combination of Masuda et al reference and the Takagi reference fail to meet the limitations of the claims, because the references fail to show that the that the recess is a deformation recess and the projection is formed on the transverse element from displaced deformation material forming the recess has not been given patentable weight. These limitations do not provide any additional structural elements than the recess and the projection that were previously claimed. As stated above, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. See MPEP 2113.

It is also argued that there is no motivation to combine the references of Masuda et al and Takagi. In paragraph 1 lines 43-62, Matsuda et al discuss the problems associated with dimensions between the projection and the recess, as does Takagi in the abstract. One having ordinary skill in the art would be motivated by the Takagi reference to modify the device of the Matsuda et al reference in order to improve the efficiency of power transmission.

The applicant's remarks have been accorded due consideration, however they are not deemed fully persuasive.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky A. Johnson whose telephone number is (703) 305-3013. The examiner can normally be reached on Monday-Thursday (7:00a-5:00p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Bucci can be reached on (703) 308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

vaj ^{very} 5/27/04

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MARCUS CHARLES
PRIMARY EXAMINER